

## REMARKS

The specification in paragraph [0030] has been amended to explicitly point out that the planar picture element is received substantially flushly against the backing plate 10, as clearly shown in the figures. This amendment is necessary to provide explicit antecedent basis for language in newly submitted claims 23 and 24.

Claim 21 has been amended to properly depend from another method claim, thereby overcoming the objection.

Independent claims 1 and 20 have been amended to define the structure recited therein more clearly, in order to distinguish more clearly over the prior art of record.

Claims 1-5, 8-10, 13, 14 and 20 stand rejected under 35 U.S.C. §103 as being unpatentable over Fossum US 6,742,294 in view of Moseson US 1,649,415. To the extent that this rejection would be applied to claims as presently amended, such rejection is traversed for the reasons following.

At the outset, it is important to understand the invention represented by the structure recited in independent claims 1 and 20, and the problem it is intended to solve. As exemplified by the title, the invention relates to a "Picture Frame Assembly for Mounting to a Cylindrical Object". As noted in the background and summary, paragraphs [0003] and [0004], an object of the invention is to provide a picture frame which may be plastically deformed to any desired radius of curvature. As such, it can be mounted flushly against a cylindrical object of any radius.

Both apparatus claim 1 and method claim 20 recite, as an essential element, a backing plate having a plurality of grooves formed in one of the surfaces, and a plurality of ribs alternating with the grooves, the thickness at the grooves being less than the thickness at the ribs, the material and thickness of the plate being chosen so that the backing plate may be plastically

deformed about a bending axis parallel to the grooves. It must be emphasized that plastic deformation should not be confused with elastic deformation. "Plastic" means capable of being shaped or formed; elastic means capable of recovering shape, i.e. resilient (American Heritage Dictionary). If applicant's backing plate were resilient, it could not achieve the object of adjusting to any desired radius of curvature without springing back to its initial shape.

Turning now to the cited prior art, Fossum discloses a support plate 30 which the examiner identifies as applicant's backing plate, and a transparent front plate 1, which the examiner identifies as applicant's frame element. The front plate 1 is formed with gripping edges 4, 5 for retaining a display plate 6 against the front plate 1. However the backing plate is not formed with grooves and is not plastically deformable. The display plate 6 is not held against the front surface of the backing plate, but only contacts the ends of the backing plate, if that. The assembly of plate 30 to the front plate 1 is described in the first paragraph of column 6, which reads as follows:

FIGS. 6a-c illustrate how the support element 30 is mounted simply and quickly in the front plate 1. As shown in FIG. 6b, the lower edge 32 of the support element is placed within the gripping edge 5, and the upper part of the support element thereafter is pushed somewhat downwards in the direction of the arrow A, so that its upper edge 31 comes beneath and inside of the upper gripping edge 4 of the front plate. The element 30 thereafter is allowed to spring back, so that its upper edge comes into engagement behind the gripping edge 4. The spring action of the material in the support element entails that the element is kept in place without any additional locking means. Mounting and dismounting of the support element thereby can take place very rapidly and simply, without a tool or other mounting parts.

From the foregoing it is clear that resilience of the support plate is absolutely critical to the teaching of Fossum. It is not plastically deformed, but elastically deformed. To provide the support plate with grooves and make it plastically deformable would defeat this teaching and render the device of Fossum inoperable, which is impermissible. See MPEP 2143.01.

Thus, regardless of what the secondary references teach, Fossum cannot be used as a primary reference to establish a *prima facie* of obviousness against applicant's claims 1 and 20, because it teaches away from the proposed modification.

Moseson is cited for disclosure of a backing plate having a plurality of parallel grooves in one of the surfaces. The examiner states that it would be obvious "...to modify Fossum as taught by Moseson to include Moseson's grooved backing plate. Such a modification would provide an improved means to hold the planar picture element in place".

It is not clear from the foregoing statement what the examiner envisions. Moseson disclosed a sheet of corrugated paper 26 which is sandwiched between a back plate 19 and a backing sheet 15 in order to load a picture 14 against glass 13. The object is to exert resilient pressure on the picture. See page 1, lines 85-95. In Fossum, however, the support plate 30 is spaced far behind the front plate 1, so that inserting the corrugated sheet 26 in this space would serve no purpose. On the other hand, if the examiner is suggesting that the corrugated paper sheet 26 be used to *replace* Fossum's support plate 30, this would clearly destroy the desired resilience. Thus, applicant cannot see any motivation to modify the device of Fossum in any way using the corrugated sheet of Moseson. Motivation or suggestion to combine is a necessary step to establishing a *prima facie* case of obviousness. See MPEP 2143.01.

Notwithstanding the lack of motivation to make the proposed combination, and the fact that it would still not meet applicant's limitation plastic deformation, applicant has amended independent claims 1 and 20 to clearly define the grooves so that they cannot possibly be read on corrugations. That is, the thickness of the sheet is now recited as being less at the grooves than it is at the intervening ribs. This is because the grooves are *formed in* a surface of the plate, as opposed to being formed by corrugating the plate, which does not change its thickness.

Given the patentability of claims 1 and 20 over the combination of Fossum and Moseson, it should not be necessary to address the rejections of various dependent claims. However several statements made by the examiner will now be addressed, for the event that it becomes necessary to rely on these claims.

Regarding claim 2, the examiner refers to grooves 16, but this reference numeral refers to a shoulder on the frame 10. Here too it is not clear how the examiner has modified the device of Fossum with the corrugated sheet 26 of Moseson, if indeed the examiner intends to refer to the sheet 26.

Regarding claim 3, the lateral edges 37, 38 do not face the front surface of the support plate 30, which the examiner identifies as applicant's backing plate. Rather, the lateral edges face the front plate 1, which the examiner identifies as applicant's frame element.

Regarding claim 4, the gripping edges 4, 5, of Fossum do not prevent movement parallel to the grooves, assuming that the grooves are formed parallel to the bends in the support plate and the front plate. Once again it would be necessary to know just how Fossum is being modified by Moseson, so that the orientation of the grooves envisaged by the examiner would be understood.

Regarding claim 5, the criticality of the triangular shape of the retaining tab is clearly explained in paragraph [0031]:

As shown in FIG. 3C, each frame element 18 has at least one end formed with a retaining tab 19 which serves as a stop to prevent a picture element 29 from sliding parallel to the grooves 14. The triangular shape of the tab 19 prevents frame element 18 from being folded too far, which could overstress the thin material in the bottom of the second groove 14.

Thus, contrary to the statement made by the examiner, the shape of the tab is not simply a matter of aesthetics. It prevents overstressing the tabs, and positively holds the picture element against movement parallel to the grooves, as depicted in Figure 3C.

The rejections of the remaining claims suffer from similar shortfalls, and cannot be fully addressed because it is not clear just how the device of Fossum is being modified with the features of Moseson, or what would motivate a skilled person to make the modification.

Applicant has reviewed the Johnson, Painsith, and Bracker references cited against various dependent claims, and does not see where any of these disclosures suggest the limitations in claims 1 or 20 as presently amended. Accordingly these references will not be addressed at this time, beyond pointing out that none of the references of record addresses the problem solved by applicant's invention, to wit, providing a picture frame that will conform to a cylindrical surface of any desired radius. Obviousness determinations must include consideration of the invention as a whole, including its structure, its properties, and the problem it solves. In re Wright, 6 USPQ 2d 1959 (Fed. Cir. 1988).


The claims as amended being definite and patentable over the art of record, withdrawal of the rejections and early allowance are solicited. If any objections remain, a call to the undersigned is requested.

A check in the amount \$50 is enclosed in payment for the addition of two new claims.

If any additional fees or charges are required at this time, they may be charged to our  
Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,

COHEN PONTANI LIEBERMAN & PAVANE LLP

By   
F. Brice Faller  
Reg. No. 29,532  
551 Fifth Avenue, Suite 1210  
New York, New York 10176  
(212) 687-2770

Dated: February 4, 2008